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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
| 087666,164 | 06/19/96 | GENISE | 94-RTRN-387 |

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PM32/0301

EXAMINER
WRIGHT, D

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 3681 | 240 |

DATE MAILED: 03/01/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/666,164

Applicant(s)
Genise, et al.

Examiner
Dirk Wright

Group Art Unit
3681



☒ Responsive to communication(s) filed on Nov 4, 1998

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-143 is/are pending in the application.

Of the above, claim(s) 35-47, 51, 52, and 58-143 is/are withdrawn from consideration.

☒ Claim(s) 48-50 and 53 is/are allowed.

☒ Claim(s) 1, 6-9, 14, 16-18, 20, 22-24, 26-30, 33, and 54-57 is/are rejected.

☒ Claim(s) 2-5, 10-13, 15, 19, 21, 25, 31, 32, and 34 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Acknowledgments

The Amendments filed November 4, 1998 and December 9, 1998 were entered. The new Declaration filed November 18, 1998 and the Petition to Correct Inventorship filed November 4, 1998 were also entered.

The Finality of the previous Office Action is withdrawn in view of the above amendments and in favor of the following Office action.

Continuing Status

The request to grant continuing-in-part status to this application under 35 USC 120 is granted in part. There are two requirements an applicant must fulfill to be granted continuing-in-part status. The first is that the child application must be filed before the parent becomes a patent or is abandoned. The second is that the child must assert the status before the parent becomes a patent or is abandoned. Two of the applications, S/N 08/649,831, and S/N 08/649,833 were abandoned at the time applicant made the claim. The request for continuing status is therefore granted for application S/N 08/649,830 only, because it was pending at the time the request was made.

Inventorship

The Petition to Correct Inventorship under 37 CFR 1.48 is granted. Mr. McReynolds and Mr. Markyvech will be added as co-inventors.

Claims

Claims 35-47, 51, 52, and 58-143 have been withdrawn from further consideration in the previous Office action.

Claims 1, 6-9, 14, 17, 18, 20, 23, 24, and 26-30 are rejected under the judicially created doctrine of double patenting over claims 1-37 of U.S. Patent No. 5,735,771 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: a semi-automatic transmission and engine fuel control system with automatic splitter shifts wherein in the controller responds to an intent-to-shift switch, and upon sensing a neutral condition in the transmission, controls the engine fueling to change the speed of an input shaft of the transmission such that the speed approaches a synchronous speed.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claims 1, 14, 16-18, 20, 22-24, 26-30, 33, and 54-57 are rejected under 35 U.S.C. §102(e) as being anticipated by Palmeri et al. '558. See the previous Office Action.

Claims 2-5, 10-13, 15, 19, 21, 25, 31, 32 and 34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Prosecution is suspended for claims 48-50 and 53 for consideration of a possible interference based on applicant's First Request for Interference.

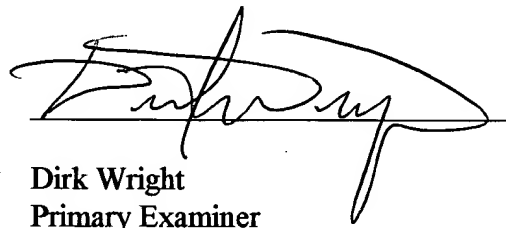
Serial Number: 08/666,164

Ex Parte prosecution is suspended in this application for consideration of a possible interference. This application will be forwarded to the Board of Appeals and Interferences.

This action is made Final. Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. §1.136(a).

A shortened statutory period for response to this action is set to expire ***three months*** from the mailing date of this action. In the event a first response is filed within two months, and an advisory action is not mailed until after the end of the three month shortened statutory period, then the shortened statutory period will expire on the date the advisory action was mailed. Any extension fee according to 37 CFR §1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period expire later than six months from the mailing date of this action.

February 26, 1999

A handwritten signature in black ink, appearing to read 'Dirk Wright', is written over a horizontal line.

Dirk Wright
Primary Examiner
Art Unit 3681